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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,776	08/06/2003	Benjamin P. Reese	REES3001/EM	7622
23364	7590	05/18/2006		
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			EXAMINER YIP, WINNIE S	
			ART UNIT 3636	PAPER NUMBER

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,776

Applicant(s)

REESE, BENJAMIN P.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 5,7,9-11,13 and 15-19 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4,6,8,12 and 14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This office action is in response to applicant's reply filed on March 2, 2005.

#### *Response to Election/Restrictions*

1. Applicant's election of species of Group IV(Figs. 17-22) in the reply filed on March 2, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 5, 7, 9-11, 13, 15-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply. Notice, claim 15 claims a support structure comprising an assembly of folding legs that read on a non-elected specie (Figs. 23-24).

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 6, 9, 12, 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 12-13 of copending Application No. 10/641,822. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application claims substantial same elements including a telescoping mast, a support structure having a base horizontal plate, a boom attachment collar slidably mounted on the mast, a boom having one end attached to the collar, and an other coupled with a hub, a plurality of radial ribs pivotally attached to the hub and supporting a canopy, and a boom support strut attached to a point of the boom as claimed except wording differently.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 9, 12, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reese (US Patent No. 6,305,394).

Reese teaches a portable sunshade comprising: a mast including an assembly of telescoping tubes (20, 22) extending in a vertical direction, a support structure (12) having a horizontally-extending plate (14) and a vertical column (16) for receiving and supporting the mast, a slidable boom attachment collar (26) slidably attached to the mast, a boom (24) having one end pivotally connected to the slidable boom attachment collar, another end coupled with a hub (48), a plurality of radial ribs (62) pivotally around the hub to support a canopy and to hold the canopy against the boom, the radial ribs (62) and the boom lie substantially a same plane, and a boom support strut (68) having one end pivotally attached to the mast above the boom attachment collar and another end pivotally attached to the boom at a point between two ends of the boom.

7. Claims 1-4, 6, 9, 12, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reese (US Patent No. 6,412,506) as discussed set for above rejection.

8. Claims 1-4, 6, 9, 12, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by (US Patent No. 6,305,394).

Reese teaches a portable sunshade comprising: a mast including an assembly of telescoping tubes (20, 22) extending in a vertical direction, a support structure (12) having a horizontally-extending plate (14) and a vertical column (16) for receiving and supporting the mast, a slidable boom attachment collar (26) slidably attached to the mast, a boom (24) having one end pivotally connected to the slidable boom attachment collar, another end coupled with a hub (48), a plurality of radial ribs (62) pivotally around the hub to support a canopy and to hold

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the canopy against the boom, the radial ribs (62) and the boom lie substantially a same plane, and a boom support strut (68) having one end pivotally attached to the mast above the boom attachment collar and another end pivotally attached to the boom at a point between two ends of the boom.

9. Claims 1-4, 6, 9, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Xu (US Patent No. 6,196,242).

Xu shows and discloses a portable sunshade comprising: a base (25), a mast structure (1), a boom attachment collar (2) slidably engaging the mast, the collar (2) selectively positioning along a portion of the mast, a boom (8) extending outwardly from the mast structure (1), the boom (8) having a first end movably attached to slidable collar (2), a hub assembly (13) attached to a second end of the boom, a plurality of ribs (15) radially extending from the hub assembly, a canopy (41) mounted over the support ribs, a boom support strut (7) having one end pivotally attached to the upper end of the mast structure by a second collar (4) and having another end pivotally secured to the boom at a predetermined point between two ends of the boom (8), wherein the base includes vertical extending tubular column (47) for receiving and supporting the mast thereon by a bolt (42) and a horizontally-extending plate (25) extending thereunder such that a heavy object may be bear on the plate for providing a sufficiently stability to maintain the mast in a vertical position. In addition, Xu further teaches the hub including an upper crown (12) and a lower runner (18), the plurality of ribs being radially and pivotally connected to the upper crown and capably lie in a same plane with the boom in an open position, and a plurality of runner support struts (16, 22) mounted on between the lower runner or the

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boom and the ribs for supporting the ribs in an open and closed position as shown in selected Figs.17-22 of claimed invention.

### *Conclusion*

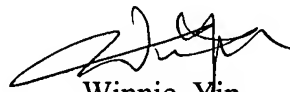
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stainer '806, Steiner '438, Glatz '069, Harbaugh '882, Ma '763, Chou '735, and Bright et al. '739 teach various portable sunshades comprising a boom, a boom support strut, and a canopy assembly arranged as similar to the claimed invention. Geniele '644, Leu '103, Lin et al. '320, Barnes '246, McCleskey '099, and Lee '967 teaches various support structures as similar to the claimed invention.

### *Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
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